

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-116 are presently active in this case, Claims 1, 14, 17, 30, 32, 35, 37, 38, 40, 45, 46, 49, 51, 52, 54, 59, 72, 88, 90, 93, 95, 96, 98, 103, 104, 107, 109, 110, and 112 having been amended by way of the present Amendment.

Claims 1-3, 6-16, 19-29, 59-61, 64-74, and 77-87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota et al. (U.S. Patent No. 6,628,591) in view of Kawase (U.S. Patent No. 6,438,631) and further in view of Serizawa et al. (U.S. Patent No. 6,219,321). Claims 4, 5, 17, 18, 62, 63, 75, and 76 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota et al. in view of Kawase and further in view of Serizawa et al. and Ludtke et al. (U.S. Patent No. 6,421,069). Claims 30, 31, 36, 45, 50, 88, 89, 94, 103, and 108 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase in view of Serizawa et al. Claims 32, 35, 39-44, 46, 49, 53-58, 90, 93, 97-102, 104, 107, and 111-116 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase in view of Serizawa et al. and further in view of Yokota et al. Claims 33, 34, 37, 38, 47, 48, 51, 52, 91, 92, 95, 96, 105, 106, 109, and 110 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase in view of Serizawa et al. and further in view of Yokota et al. and Ludtke et al. For the reasons discussed below, the Applicant requests the withdrawal of the obviousness rejections of independent Claims 1, 14, 30, 45, 59, 72, 88, and 103.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicant submits that a *prima facie* case of obviousness has cannot be established in the present case because the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations.

Claim 1 of the present application recites a method comprising, among other features, a transmitting step comprising transmitting information to a computer in order for the device of the computer to write the information to a recordable medium without writing any of the information to an intermediate storage device when the determining step determines that the device is an appropriate device for writing to the removable medium. Claim 14 recites a method comprising, among other features, a writing step comprising writing information to a removable medium using the device, without writing any of the information to an intermediate storage device when it is determined that the device is an appropriate device for writing to the removable medium. Claim 59 recites a system comprising, among other features, a means for transmitting information to a computer in order for the device of the computer to write the information to a recordable medium without writing any of the information to an intermediate storage device when the means for determining determines that the device is an appropriate device for writing to the removable medium. Claim 72 recites a system comprising, among other features, a means for writing information to a removable medium using the device, without writing any of the information to an intermediate storage device when it is determined that the device is an appropriate device for

writing to the removable medium. The Applicant submits that the cited references, either taken singularly or in combination, fail to disclose or suggest the limitations recited above.

The Official Action notes that the Yokota et al. reference and the Kawase reference “do not specifically disclose transmitting the information to the computer in order for the device of the computer to write the information to the recordable medium without writing to an intermediate storage device, when the determining step determines that the device is an appropriate device for writing to the removable medium.” The Official Action cites the Serizawa et al. reference for the teaching of these elements. More specifically, the Official Action refers to Figures 4(b)-7(b) and column 14, lines 16-21, for the teaching of these elements. The Official Action also notes that the Serizawa et al. reference states that “many of the data from the upper apparatus are directly recorded on the optical disk unit through a hard disk difference buffer managing portion.” However, the Applicant respectfully submits that the Serizawa et al. reference does not disclose transmitting information to a computer in order for the device of the computer to write the information to a recordable medium or writing the information to the removable medium *without writing any of the information* to an intermediate storage device *when the determining step determines that the device is an appropriate device for writing to the removable medium*.

The Serizawa et al. references depicts in Figures 4(a), 5(a), 6(a), and 7(a) a conventional system and method in which data from an “upper apparatus” is sent to a hard disk unit via a hard disk buffer managing portion. The data is then sent from the hard disk unit to an optical disk unit via the hard disk buffer managing portion. Figures 4(b), 5(b), 6(b), and 7(b) depict the invention in which “many of the data from the upper apparatus are

directly recorded on the optical disk unit through a hard disk difference buffer managing portion.” (Column 14, lines 15-19.) However, this phrase clearly indicates that some of the data is sent to the hard disk unit before being sent to the optical disk unit, and thus the Serizawa et al. reference does not disclose an embodiment in which information is transmitted to a computer in order for the device of the computer to write the information to a recordable medium or writing the information to the removable medium *without writing any of the information* to an intermediate storage device *when the determining step determines that the device is an appropriate device for writing to the removable medium*. In the invention of the Serizawa et al. reference, “the data which cannot be recorded on the optical disk unit (difference data) are recorded on the hard disk.” (Column 14, lines 19-21.) The Serizawa et al. reference describes an invention in which the difference data will necessarily be stored in the hard disk unit. Furthermore, the Serizawa et al. reference describes an invention in which the data fed from the upper apparatus is greater than the recording speed of the optical disk unit (see, e.g., the Abstract) in order to achieve the objectives set forth in the Serizawa et al. reference (see column 2, lines 57-60).

Thus, the Serizawa et al. reference does not supplement the deficiencies in the teachings of the Yokota et al. and Kawase reference noted in item number 9 on pages 3-4 of the Official Action. More specifically, the Serizawa et al. reference does not disclose transmitting information or writing the information to the removable medium without writing any of the information to an intermediate storage device when the determining step determines that the device is an appropriate device for writing to the removable medium, since, as mentioned above, the Serizawa et al. reference clearly teaches an invention in which

difference data will necessarily be stored in a hard disk unit before sending to the optical disk unit. Accordingly, the Applicant respectfully requests the withdrawal of the obviousness rejection of Claims 1, 14, 59, and 72.

Claims 2-13, 15-29, 60-71, and 73-87 are considered allowable for the reasons advanced for Claims 1, 14, 59, and 72 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claims 1, 14, 59, and 72.

Claims 30, 45, 88, and 103 of the present application recite methods and systems comprising, among other features, information that includes first importance information and second importance information having an importance which is lower than the first importance information, and writing or transmitting the second importance information to a storage medium which is different from the hard disk drive, *without writing any of the second importance information to the hard disk drive when a device configured to write to the storage medium does satisfy predetermined criteria*. The Applicant submits that the cited references, either taken singularly or in combination, fail to disclose or suggest the limitations recited above.

As discussed above, neither the Kawase reference, nor the Serizawa et al. reference disclose or suggest transmitting information to a storage medium which is different from the hard disk drive, without writing any of the information to the hard disk drive when a device configured to write to the storage medium does satisfy predetermined criteria. The Serizawa et al. reference clearly teaches an invention in which difference data will necessarily be stored

Application Serial No.: 09/764,270
Reply to Office Action dated October 27, 2004

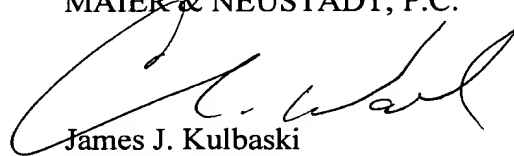
in a hard disk unit before sending to the optical disk unit. Accordingly, the Applicant respectfully requests the withdrawal of the obviousness rejection of Claims 30, 45, 88, and 103.

Claims 31-44, 46-58, 89-102, and 104-116 are considered allowable for the reasons advanced for Claims 30, 45, 88, and 103 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claims 30, 45, 88, and 103.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Registration No. 34,648
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

JJK:CDW:brf
I:\atty\cdw\199527US2X\am2.doc